

## **REMARKS/ARGUMENTS**

Claims 1-4, 6-13 and 15-18 are currently pending in this application. Applicants have amended claims 1, 8-10, 17, and 18. Reconsideration and further examination are respectfully requested.

### **Claim Objections**

The Office Action objected to certain language in claim 9. Applicants have amended claim 9 and submit that all claims, as amended, are acceptably worded.

### **35 U.S.C. § 103**

The Office Action rejected claims 1, 6, 8-10 and 15 under 35 U.S.C. § 103(a) based on Choi et al., U.S. Pat. No. 6,757,537 ("Choi") in view of Saints et al., U.S. Pat. No. 5,872,775 ("Saints") in further view of Rhoads, U.S. Pat. No. 6,278,781 ("Rhoads"), and in still further view of LaRosa, U.S. Pat. No. 6,628,965 ("LaRosa"), and in even further view of Wortham, U.S. Pat. No. 6,748,226 ("Wortham"). The Office Action rejected dependent claims 2 and 11 under 35 U.S.C. § 103(a) based on Choi in view of Saints in further view of Rhoads in still further view of LaRosa and in even further view of Wortham and in yet further view of Balachandran, U.S. Pat. No. 6,608,828 ("Balacahndran"). The Office Action rejected dependent claims 3, 4, 12, and 13 under 35 U.S.C. § 103(a) based on Choi in view of Saints in further view of Rhoads in still further view of LaRosa and in even further view of Wortham and in yet further view of Guo et al., U.S. Pat. No. 6,389,034 ("Guo"), and claims 7 and 16-18, including independent claims 17 and 18 under 35 U.S.C. § 103(a) based on Choi in view of Saints in further view of Rhoads in still further view of LaRosa and in even further view of Wortham and in yet further view of Moon et al., U.S. Pat. No. 6,643,272 ("Moon").

Applicants submit that the Office Action overstates the content of several cited references. Beginning with Choi, Claim 1 is rejected because Choi purportedly shows "determining an energy value (i.e. power control parameter has been interpreted as energy value) (see the abstract, column 2, lines 41-52 [of Choi]...locating the energy value in a look-up table

(see column 2, lines 46-47 wherein memory has been interpreted as a look-up table); forming a message carrying the energy value (see Fig. 12, block 1214)...” Office Action, p. 4.

This is wrong on many levels. First, the limitation in claim 1 is “forming a message carrying an indicator of the energy value, ...wherein the energy value is a traffic-to-pilot ratio...” The Choi “power control parameter value” is not an energy value, i.e. a traffic-to-pilot ratio, but instead is a flag or indicator of when outer loop power control should be applied in the Choi design. *See, e.g.*, Choi, col. 10, ll. 40-57; col. 12, l. 47 – col. 13, l. 32; claims 4 and 13 (“wherein the power control parameter value is comprised of a value for setting whether to perform outer loop power control [i.e. a flag], a target frame error rate (FER) [not an energy value], a minimum value of transmission power [not an energy value as defined in the claim], and a maximum value of transmission power [also not an energy value as defined in the claim]”) Thus the Choi power control parameter value is not an “energy value” as defined by the claims, is merely a value used to decide when to control Choi power, and has nothing to do with traffic-to-pilot ratio as claimed.

Choi does not recite a look-up table as claimed, despite contentions to the contrary in the Office Action. *See, e.g.*, Office Action, p. 4. A memory is a memory and a look-up table is a look-up table; these are two different things. The Office Action attempts to characterize the Choi memory as the claimed look-up table, which it is not.

Further, no message is formed carrying an energy value. The Choi message generator 1214 certainly generates a message, but the description in Choi of the message generator states that message generator 1214 “transmits the generated service connect message...” and nothing more. Choi, col. 15, ll. 38-41. The Office Action errantly assumes that certain information, such as Choi’s power control parameter value, is included in the message, despite Choi failing to disclose or suggest inclusion of such information. In short, Choi is a different design, operates in a different manner, and does not include the express limitations recited in the present claims. The Office Action attempts to “fill in the gaps” of Choi, which is improper.

The Office Action recognizes some of the deficiencies of Choi and goes on to cite Saints. Saints is apparently cited for the limitation of “selecting an index value associated with the

energy value, and forming a message carrying the index value...As to the first limitation..." Office Action, p. 4. However, the Office Action then goes on to discuss power-to-pilot ratio, claiming "cell site N" transmits an initial ratio of full-rate frame power to pilot power..Saints discloses that rate determined by the rate determination unit is then used to properly decode the frame of data..." Office Action, pp. 4-5.

This rejection based on Saints is confusing and entirely unclear. The Office Action is apparently relying on Saints for the Saints traffic-to-pilot ratio, which is disclosed in Saints at col. 7, ll. 52-53, for example. However, a complete reading of Saints, including but not limited to col. 7, l. 47 through col. 8, l. 3, indicates that traffic-to-pilot is computed by rate processor 46, a device in the mobile unit used in decoding the message. Traffic-to-pilot is not an energy value or other value wherein a message is formed carrying an indicator of energy value, wherein the energy value is a traffic-to-pilot ratio. It is as if the Office Action cites certain terms in these various references and merely plugs them into the present claims irrespective of the wording employed in the claims. This is improper, and demonstrates hindsight reconstruction of the claims.

Simply put, the Office Action appears to want to take the Saints traffic-to-pilot ratio, ignore the fact that this parameter is computed and employed at the Saints receiver and not explicitly transmitted within a message or in any way conveyed between, for example, two stations. The Office Action seeks to plug the Saints traffic-to-pilot ratio into Choi as being the same as the "power control parameter value" of Choi, claiming that computation of such an "energy value" and transmission in a message from one station to a second station is obvious. This is wrong in numerous ways, both technologically and from an obviousness analysis standpoint. The mere recitation in Saints of a power-to-pilot ratio does not evidence obvious of the claim limitation.

The Office Action goes on to acknowledge that energy values are not shown by Rhoads, but cites Rhoads for the "determining an energy value" limitation of the claims. Rhoads discloses methods and systems for reducing theft of wireless telephony services. Rhoads, Abstract. In particular, Rhoads discloses coding a message to determine whether the message is

received correctly. Rhoads, col. 12, ll. 6-27. Rhoads is directed to determining whether a call is fraudulent. In contrast, the present claims are directed to improving the performance of a decoder using energy values. Rhoads does not mention anything about energy values or using energy values to improve the performance of decoders.

Further, Rhoads discloses a telephone that randomly generates a number between 1 and 256, which serves as an index to these stored messages. Rhoads, col. 12, ll. 8-10. Applicants have amended the claims to recite determining an energy value includes locating the energy value in a look-up table and selecting an index value representing the energy value. In Rhoads, the index is a random number representing nothing, and certainly not energy values. As discussed, neither Choi nor Saints show the claimed energy values, in particular being a traffic-to-pilot ratio. For this further reason, the claims are not obvious based on the cited combination.

For at least the foregoing reasons, the present claims, as amended, include limitations neither disclosed nor suggested by the cited references. Choi, Saints, and Rhoads are missing express limitations found in independent claim 1, as well as independent claims 8-10, 18, and 19, as amended. Claims depending from these allowable claims are also allowable as they include limitations not found in the cited references, alone or in combination.

#### *Combination of References*

Applicants further note that certain references are cited for the proposition of not what they show, but what they “might” show or that it would have been obvious to extend the disclosures to include some aspect or design feature not present in the references themselves. Such “filling in” of references is improper and constitutes reliance on general knowledge of the Examiner, which is improper. MPEP 2144.03 (“If the applicant traverses [] an assertion [that a concept is ‘well known’ or ‘matters of common knowledge’] the examiner should cite a reference in support of his or her position.”).

With respect to combining references, the Examiner has the initial duty of supplying the requisite factual basis and may not, because of doubts that the invention is patentable, resort to

speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in the factual basis. *See In re Warner*, 379 F.2d 1101, 1017 (CCPA 1967). .

Here, the Examiner does not cogently explain how to modify the Choi outer loop power control device with the Rhoads random number message indexing, the traffic-to-pilot ratio computed at the Saints receiving device, and the TOA functionality of Wortham, for example. Applicants submit that it is important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does. *KSR Int'l.*, 550 U.S. at 418. The conclusion of obviousness appears born from the use of impermissible hindsight reconstruction in view of Appellants' Specification.”

“To support a conclusion that a claim is directed to obvious subject matter... an Examiner must present a “convincing line of reasoning” as to why one of ordinary skill in the art would have found the claimed invention to have been obvious. *Ex parte Clapp*, 227 USPQ 972, 973 (BPAI 1985). When determining whether a rejection based on design choice is appropriate, the Examiner must review the Specification and ascertain if the limitation in question is disclosed as serving any advantage or particular purpose, or whether it solves a stated problem. The Examiner also should explain the reasoning used to determine that the prior art would have performed equally as well as the claimed invention. These two steps help present a “convincing line of reasoning.” *Ex parte Clapp*, 227 USPQ at 973.

The Office Action presents no convincing line of reasoning for combining the references in the manner suggested other than various terse, conclusory (or inapposite) statements. For example, the deficiencies of Choi are filled in with Saints “to use a traffic-to-pilot ratio...[and/or] to extract the original transmitted data from the coded information received from the base station.” Office Action, p. 5. These are not motivations to combine – combining references “to use a pilot-to-traffic ratio” is tantamount to saying that the reason for combining reference A with reference B is because then you would have A and B, where A and B are claimed. The second suggested motivation is not a motivation to combine, as neither reference discloses nor suggests what is presumed by such a statement, namely that such an extraction is necessary based on the Choi and/or Saints reference.

The motivation to combine Choi and Saints is said to be “to achieve a higher level of security in the system.” Office Action, p. 5. How does security apply here? This is not a motivation to combine – it is an after-the-fact justification of combining two unrelated references to invalidate the claims. The motivation to employ LaRosa is “to improve error correction and detection at the receiver,” again a conclusory statement that is not really a motivation but instead a justification. Office Action, p. 6. Wortham is lumped in “to facilitate determination of the location of the mobile unit,” again a justification and not a motivation. Office Action, p. 7.

Applicants submit that there is no reasoning supporting combining the cited references, including Choi, Saints, Rhoads, LaRosa, and Wortham, and the other cited references, and that it is only through the use of impermissible hindsight that the Applicants’ claims may be constructed from the reference and purported knowledge in the art. Such hindsight reconstruction of the invention is impermissible. *In Re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991); *In Re Laskowski*, 871 F.2d 115, 117 (Fed. Cir. 1989); *see also, Ex Parte Lange*, 72 U.S.P.Q. 90, 91 (C.C.P.A. 1947).

The Patent Office must show that some reason to combine the elements with some rational underpinning that would lead an individual of ordinary skill in the art to combine the relevant teachings of the references. *KSR International Co. v. Teleflex Inc.*, No. 04-1350, 550 U.S. \_\_\_\_ (2007); *In re Fine*, 837 F.2d 1071, 1074 (Fed. Cir. 1988). Therefore, a combination of relevant teachings alone is insufficient grounds to establish obviousness, absent some reason for one of ordinary skill in the art to do so. *Fine* at 1075.

None of the references, alone or in combination, teaches the unique features called for in the claims. It is impermissible hindsight reasoning to pick a feature here and there from among the references to construct a hypothetical combination which obviates the claims.

It is impermissible, however, simply to engage in a hindsight reconstruction of the claimed invention, using the applicant’s structure as a template and selecting elements from references to fill the gaps. [*citation omitted*]

*In re Gordon*, 18 USPQ.2d 1885, 1888 (Fed. Cir. 1991).

A large number of devices may exist in the prior art where, if the prior art be disregarded as to its content, purpose, mode of operation and general context, the several elements claimed by the applicant, if taken individually, may be disclosed. However, the important thing to recognize is that the reason for combining these elements in any way to meet Appellants' claims only becomes obvious, if at all, when considered from hindsight in the light of the application disclosure. The Federal Circuit has stressed that the "decisionmaker must step backward in time and into the shoes worn by a person having ordinary skill in the art when the invention was unknown and just before it was made." *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561, 1566 (Fed. Cir. 1987). To do otherwise would be to apply hindsight reconstruction, which has been strongly discouraged by the Federal Circuit. *Id.* at 1568.

To imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher.

*W.L. Gore & Assoc. v. Garlock, Inc.*, 721 F.2d 1540, 1553 (Fed. Cir. 1983). Therefore, without some reason in the references to combine the cited prior art teachings, with some rational underpinnings for such a reason, the Examiner's conclusory statements in support of the alleged combination fail to establish a *prima facie* case for obviousness. *See, KSR International Co. v. Teleflex Inc.*, No. 04-1350, 550 U.S. \_\_\_\_ (2007) (obviousness determination requires looking at "whether there was an apparent reason to combine the known elements in the fashion claimed...," citing *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006) ("[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness," KSR at 14).

Simply stating that the invention would have been obvious to a person of ordinary skill is also insufficient, for the assertion must be supported by clear and convincing evidence. *Panduit, supra*, 810 F.2d at 1568. The Office Action merely states that the invention would be obvious in light of the proposed combination, and did not provide clear and convincing evidence or reasoning to support this assertion.

The Examiner has failed to avoid the effects of hindsight reasoning in fashioning the combination of Choi, Saints, Rhoads, LaRosa, and Wortham, and for these further reasons, independent claims 1, 8-10, 18, and 19, as amended, are allowable. Claims depending from allowable claims 1, 8-10, 18, and 19, as amended, are also allowable as they include limitations missing from the cited references.

Accordingly, it is respectfully submitted that all pending claims fully comply with 35 U.S.C. § 103.

## CONCLUSION

In view of the foregoing, it is respectfully submitted that all claims of the present application are in condition for allowance. Reexamination and reconsideration of all of the claims are respectfully requested and allowance of all the claims at an early date is solicited.

It is believed that all of the pending claims have been addressed. However, the absence of a reply to a specific rejection, issue or comment does not signify agreement with or concession of that rejection, issue or comment. In addition, because the arguments made above may not be exhaustive, there may be reasons for patentability of any or all pending claims (or other claims) that have not been expressed. Finally, nothing in this paper should be construed as an intent to concede any issue with regard to any claim, except as specifically stated in this paper, and the amendment of any claim does not necessarily signify concession of unpatentability of the claim prior to its amendment.

Applicants believe that no fees are due in accordance with this Response beyond those included herewith. Should any fees be due, the Commissioner is hereby authorized to charge any deficiencies or credit any overpayment to Deposit Account No. 17-0026.

Respectfully submitted,

Date: March 3, 10

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